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June 4, 2003

File: 4001.002282

CERTIFICATE OF MAILING
37 C.F.R. § 1.8

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date below:

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Shelley P.M. Fussey

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RE: U.S. Application Serial No. 09/351,862; Entitled "Cancer Treatment Kits Using Antibodies to Aminophospholipids"; By Thorpe and Ran; Client Ref.: UTSD:549--1

Sir:

Enclosed for filing in the above-referenced patent application is:

- (1) A Petition to Withdraw Finality of Third Office Action Under 37 C.F.R. §1.181, MPEP 706.07(c)(d) and 707.07(d)(g)(i); and
- (2) A postcard listing these materials; please date stamp and return the postcard evidencing receipt of these materials.

WILLIAMS, MORGAN & AMERSON, P.C.

Commissioner for Patents
June 4, 2003
Page 2

Should any fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to the enclosed materials, the Assistant Commissioner is authorized to deduct fees from Williams, Morgan & Amerson, P.C. Deposit Account No. 50-0786/4001.002282.

Respectfully submitted,



23720

PATENT TRADEMARK OFFICE

A handwritten signature in black ink, appearing to read "S. Fussey".

Shelley P.M. Fussey, Ph.D.
Reg. No. 39,458
Patent Agent

Encls.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#34

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JUN 10 2003

In re Application of:

Philip E. Thorpe and Sophia Ran

Serial No.: 09/351,862

Filed: July 12, 1999

For: CANCER TREATMENT KITS USING
ANTIBODIES TO
AMINOPHOSPHOLIPIDS

Group Art Unit: 1617

TECH CENTER 1600/2900

Examiner: Sharareh, S.

Atty. Dkt. No.: 4001.002282

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June 4, 2003
Date


Shelley P.M. Fussey

**PETITION TO WITHDRAW FINALITY OF THIRD OFFICE
ACTION UNDER 37 C.F.R. § 1.181, MPEP 706.07(c)(d) AND 707.07(d)(g)(i)**

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants petition that the holding of finality set forth in the third and originally Final Official Action dated October 22, 2002 ("the Third Action") be withdrawn according to MPEP 706.07(c)(d) and 37 C.F.R. § 1.181. The finality of the Third Action was premature, most particularly as it entered a new ground of rejection against unamended independent claims. Finality was timely contested in Applicants' Request filed April 22, 2003 ("the Request"). The request to withdraw finality was denied in an Advisory Action dated May 29, 2003. The denial was not properly based and Applicants therefore petition that finality be withdrawn as improper.

A. Summary

The finality of the Third Action was premature as the Action entered a new ground of rejection against several unamended claims, including a new ground of rejection against independent, unamended claims 39-42, which was not necessitated by Applicants' amendment or untimely submission of references. The Advisory Action denied Applicants' Request to withdraw finality on the basis that the Office had earlier "effectively rejected" the newly rejected claims, including claims 39-42. The proposed "effectively rejected" strategy contravenes MPEP 707.07(d)(g)(i) and is improper. Premature finality of the Third Action has thus been established and finality should be withdrawn.

B. The Third Action was Prematurely Final

Applicants' Request summarized why finality of the Third Action was premature. Prior to the Second Official Action, claims 1-30 and 34-42 were pending, of which claims 1, 34, 37, 38, 39, 40, 41 and 42 were independent claims. The Second Action rejected claims 23-29, 34 and 35 under 35 U.S.C. § 103(a) as allegedly being legally obvious over the Schroit, Gimbrone and Umeda references in combination. Applicants submitted a response on the merits, rebutting the § 103(a) rejection over Schroit, Gimbrone and Umeda in the remarks section, amending claims 1, 30, 34, and 38 and adding claim 43. Independent claims 37, 39, 40, 41 and 42 were not amended.

The Third Action rejected claims 1, 3-12, 14, 19-29, 34, 35 and 39-43 under § 103(a) over Schroit, Gimbrone and Umeda. This was a new ground of rejection against several unamended claims, including against independent, unamended claims 39-42, which was not necessitated by Applicants' amendment or untimely submission of references. Finality was thus premature and should be withdrawn.

C. The Advisory Action is in Error

The Advisory Action's denial of Applicants' Request to withdraw finality is based on erroneous reasoning. Applicants therefore petition under 37 C.F.R. § 1.181 to seek supervisory review of the Advisory Action and petition that finality be withdrawn as improper.

The Advisory Action denies the Request to withdraw finality on the basis that "claims 3-12, 14, 19-22 and 39-42 were *effectively rejected* under 35 U.S.C. § 103(a) in the previous Office Action" and because "Applicants were *on proper notice* that claims 3-12, 14 and 19-22 were also rejected under 103(a)" (Advisory Action, emphases added). There is no justification for such a position.

In contrast, "the examiner's action will be complete as to all matters". 37 C.F.R. § 1.104; MPEP 707.07. "Where a claim is refused for any reason relating to the merits thereof it should be 'rejected' and the ground of rejection fully and clearly stated, and the word 'reject' must be used. The examiner should designate the *statutory basis* for any ground of rejection by express reference to a section of 35 U.S.C. in the opening sentence of each ground of rejection". MPEP 707.07(d). "The examiner ordinarily should reject each claim on all valid grounds available, avoiding, however, undue multiplication of references". MPEP 707.07(g). In every office action, each pending claims should be mentioned by number, and its treatment or status given." MPEP 707.07(i).

Thus, there is no legal or procedural basis for the position in the Advisory Action that claims can be *effectively rejected* by analogy to other rejected claims and/or other statutory grounds. The Advisory Action's improper attempt to extrapolate from the actual rejections of record to a hypothetical "effective" rejection is particularly inapplicable to unamended, independent claims 39-42. The Advisory Action therefore improperly denied the original Request to withdraw finality, which should now be granted.

D. Conclusion

Finality was premature and effectively challenged, and the Advisory Action's refusal to withdraw finality was not properly based. Applicants' petition that finality be withdrawn is in accordance with MPEP 706.07(c)(d) and MPEP 707.07(d)(g)(i) and should be granted under 37 C.F.R. § 1.181 and MPEP 1002.02(c). The petition is timely filed within two months of the action complained of (the Advisory Action of May 29, 2003).

37 C.F.R. § 1.181(d), MPEP 706.07(c)(d) and MPEP 1002.02(c) do not indicate that a fee is required for this petition. However, should a petition fee be deemed necessary, the Commissioner is authorized to deduct said fee from Williams, Morgan & Amerson, P.C. Deposit Account No. 50-0786/4001.002282. Applicants reserve the right to request a refund for any fees deducted in error and/or upon granting of this petition, along with a refund of the Notice of Appeal fee, which would not be required in light of the premature finality.

Should the Office have any questions, a telephone call to the undersigned Applicants' representative is earnestly solicited.

Respectfully submitted,



23720
PATENT TRADEMARK OFFICE

A handwritten signature in black ink, appearing to read "Shelley P.M. Fussey".

Shelley P.M. Fussey, Ph.D.
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Agent for Applicants

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Date: June 4, 2003